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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,950	02/12/2004	Tommy Rodrigues	FDN-2797	7092

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Attn: William J. Davis, Esq.
GAF MATERIALS CORPORATION
Legal Department, Building No. 10
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EXAMINER

GILBERT, WILLIAM V

ART UNIT PAPER NUMBER

3635

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,950	Applicant(s) RODRIGUES ET AL.	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 2,6,7,32,33 and 36-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-31,34,35 and 50-52 is/are rejected.
- 7) ☒ Claim(s) 16,18,20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a First Action on the Merits resulting from a Response to Election/Restriction Action dated 21 July 2006. Claims 1-52 are pending. Claims 2, 6, 7, 32, 33 and 36-49 are withdrawn from consideration. Claims 1, 3-5, 8-31, 34, 35 and 50-52 are examined as noted below.

Election/Restrictions

1. **Claims 2, 6, 7, 32 and 33** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21 July 2006. In particular to Claim 2, Applicant claimed a "square shape [notch]", but the Figures elected (Figures 1-18 per Page 1, line 14 of the Response) all show a "triangle notch". Only Figure 23, which was not elected, shows a square notch.

Claims 36-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21 July 2006.

Information Disclosure Statement

The information disclosure statement filed 12 February 2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. **The Examiner did observe the prior art submitted per the improper Information Disclosure Statement, but correction is required to conform to 37 CFR 1.98(a)(1).**

Claim Objections

Applicant is advised that should claim 16 be found allowable, claims 18 and 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference

Art Unit: 3635

in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8-12, 16-23, 25-31, 34, 35 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Bondoc et al. (U.S. Patent No. 6,105,329).

Regarding Claims 1, Bondoc discloses a shingle (Figure 5, generally) having a head lap (Figure 1, element 3) and a butt (Figure 1, element 4), an alignment notch (Figure 1, element 6) and at least one corner corresponding to the notch (element "A" from attached Figure 5 from Bondoc, below).

Regarding Claim 3, the notch (6) has a triangle shape and a corner corresponds to a side of the triangle (element "A" from attached Figure 5 from Bondoc, above).

Regarding Claim 5, the anterior layer has at least one alignment notch (6) and the posterior layer has at least one corner corresponding to the alignment notch (element "A" from attached Figure 5 from Bondoc, above).

Art Unit: 3635

Regarding Claims 8, 29, 34, 35 and 52), Bondoc discloses a shingle with at least one layer (per Claim 29), a posterior layer (15, per Claims 8, 34, 35, 52) with a head lap (element "B" from attached Figure 5 from Bondoc, above, per Claim 8, 52) and tabs (element "C" from attached Figure 5 from Bondoc, above, per Claim 8, 52), an anterior layer positioned on the posterior layer (1, per Claims 8, 34, 35, 52), an anterior head lap (Figure 1, element 3, per Claims 8, 35, 52), an alignment notch (Figure 1, element 6, per Claims 8, 35, 52) and at least one anterior tab (Figure 1, element 2) positioned on the posterior tabs (per Claims 8, 52). The phrases "formed from...length", per Claim 29, line 1, "formed from...layer", per Claim 34 line 3 and "formed form...length" per Claim 35, line 3, "formed from...layer" per Claim 52 line 3 are statements of the process of making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim.

Regarding Claim 9, the alignment notch (6) is triangular shape.

Regarding Claim 10, there are four posterior tabs (see Figure 4, area proximate element 20).

Regarding Claim 11, the anterior and posterior tabs have first and second breadths respectively, and the second breadth is greater than the first breadth (see Figure 5 generally).

Regarding Claim 12, the anterior tab has granules of a first shade and the posterior tabs have a second shade (Abstract, lines 1-2 and 20-21; Column 4, lines 52-64).

Regarding Claim 16, 18 and 20, the posterior tabs (element C above) extend beyond the anterior tab (2; see Figure 5, generally).

Regarding Claims 17, 19 and 21 the anterior head lap (Figure 9, area proximate element 40, per Claims 17, 19, 21) extends beyond the posterior head lap (Figure 9, area proximate element 44, per Claim 17) the anterior head lap edge aligns to a posterior head lap edge (Figure 9, element 48, see area proximate element 42 where dotted line represents how the two headlaps may align, per Claim 19) and the posterior head lap extends beyond the anterior head lap (element "D" from attached Figure 5 from Bondoc, above, where the posterior head lap extends beyond the anterior headlap, per Claim 21).

Regarding Claims 22 and 23, Bondoc discloses two anterior tabs (Figure 8, element 60 per Claim 22) and three anterior tabs (Figure 8, element 60 per Claim 23).

Art Unit: 3635

Regarding Claim 25, the anterior tab (2) has a corner that corresponds to the alignment notch (see area proximate element A from attached Figure 5 above).

Regarding Claim 26, the posterior tabs (element "C" from attached Figure 5 from Bondoc, below) have corners (area proximate "A" above) that correspond to the alignment notch (6).

Regarding Claim 27, the anterior tab is positioned substantially centered on the posterior tab (element "E" from attached Figure 5 from Bondoc, above).

Regarding Claim 28, the anterior tab is positioned offset from the posterior tab (element "F" from attached Figure 5 from Bondoc, above).

Regarding Claim 30, the shingle has an anterior layer (1) and a posterior layer (15).

Regarding Claim 31, the phrase "formed from...length" per line 1 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim.

Art Unit: 3635

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc et al. in view of Elliott et al. (U.S. Patent No. 6,421,976) and Stahl et al (U.S. Patent No. 6,305,138).

Regarding Claim 13, Bondoc discloses the claimed invention except a shadow band positioned at an interface between the posterior tabs and headlap and a shadow tip on the lower edge of the posterior tab of a third shade. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs, and Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott and Stahl with the shingle in Bondoc because the

Art Unit: 3635

shadings are aesthetic and provide no structural limitation to the claimed invention.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of Stahl.

Regarding Claim 14, Bondoc discloses the claimed invention except a shadow tip on the lower edge of the posterior tab. Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Stahl with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of Elliott.

Regarding Claim 15, Bondoc discloses the claimed invention except a shadow band positioned at an interface between the posterior tabs and headlap. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs (48). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott with the

Art Unit: 3635

shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc.

Regarding Claim 24, Bondoc discloses the claimed invention except the spacing of the posterior tabs. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to make the shingle in Bondoc with these dimensions because Applicant failed to state a criticality for this spacing and the shingle in Bondoc is capable of being made in such a manner.

Claims 50 and 51 rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc.

Regarding Claim 50, Bondoc does not disclose a method of installing a shingle by affixing a shingle to the roofing area, affixing another course to the roof by aligning the cut corner of one course with the alignment notch of the previous course, and repeating the above steps until the roof is completely covered. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to install the shingle in Bondoc in this manner because the shingle in Bondoc has the alignment notch (6) which is noted as an orienting means (Column 5 line 1) which would provide proper

Art Unit: 3635

alignment of subsequent courses of shingles to cover the entire surface of the structure.

Regarding Claim 51, only the method of installing the shingle is claimed. The phrase, "formed from...length" line 2 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in the claimed manner, then it meets the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571.272.6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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